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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,897	08/07/2000	William A. Royall, Jr.	ROY B-747	3640

7590 05/16/2003

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/633,897

Applicant(s)

ROYALL, JR. ET AL.

Examiner

Jonathan Ouellette

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 15-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/7/2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of 1-14 in Paper No. 7 is acknowledged.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
3. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).
4. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 1-14 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-11 of copending Application No. 09/961,234. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.
6. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: target marketing of candidates for possible enrollment into an educational institution.
7. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
9. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over CollegeEdge (www.collegeedge.com and “CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999).

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10. As per independent Claims 1 and 6, CollegeEdge discloses a method for profiling an inquiry pool of candidates in attending an institution of higher learning preliminarily to providing an application for enrollment, the method comprising the steps of: (a) providing a data base including information related to candidates for enrollment and the preferences of the institution for students with predetermined characteristics; (b) electronically evaluating the candidates in the data base against a first predetermined profile and (c) providing a report of the electronic evaluation ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999).
11. CollegeEdge fails to expressly disclose the first predetermined profile including: (i) to the extent available in the data base, information as to the candidate's high school class year, the prior visit of the candidate to the institution, and the source of the information about the candidate's initial contact with the institution in the data base, and (ii) the preferences of the institution.
12. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The candidate recruiting method would be performed regardless of the information included in the candidate profile. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
13. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included information as to the candidate's high school class

year, the prior visit of the candidate to the institution, and the source of the information about the candidate's initial contact with the institution in the data base, and the preferences of the institution in the first predetermined profile, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

14. As per Claim 2, CollegeEdge discloses wherein the first predetermined profile includes the gender and ethnicity of each candidate; and wherein the report of the electronic reevaluation includes an evaluation of the degree of gender and ethnicity representation of the candidates in the database ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999; and www.collegeedge.com).
15. As per Claim 3, CollegeEdge discloses wherein the first predetermined profile also includes the geographic area residence of each candidate; and wherein the report of the electronic reevaluation also includes an evaluation of the degree of geographic area of residence representation of candidates in the database ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999; and www.collegeedge.com).
16. As per Claims 4 and 7, CollegeEdge discloses (d) preparing a mailing list as a function of evaluated interest ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999; and www.collegeedge.com).

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17. As per Claims 5 and 8, CollegeEdge discloses wherein the data base includes a list of available documentation about the institution (relating to preselected features of the institution); and including the further steps of: (g) selecting documentation for mailing as a function of the profiling; and (h) mailing the selected documentation ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999; and www.collegeedge.com).
18. As per independent Claim 9, CollegeEdge discloses a method for profiling an inquiry pool of candidates in attending an institution of higher learning preliminarily to providing an application for enrollment, the method comprising the steps of: (a) providing a data base including information related to candidates for enrollment and the preferences of the institution for students with predetermined characteristics; (b) electronically evaluating the candidates in the data base against a first predetermined profile; and (f) providing a report of the electronic (re)evaluation ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999).
19. CollegeEdge fails to expressly disclose the first predetermined profile including: (i) to the extent available in the data base, information as to the candidate's high school class year, the prior visit of the candidate to the institution, and the source of the information about the candidate's initial contact with the institution in the data base, and (ii) the preferences of the institution.
20. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited, and it would have been obvious to one of

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ordinary skill in the art to include this data in the system disclosed by CollegeEdge (see rejection of independent Claims 1 and 6).

21. CollegeEdge also fails to expressly disclose (c) electronically requesting predetermined information from the selected candidates; (d) entering the electronic responses to the electronic request for information into the database; (e) electronically reevaluating the selected candidates in the data base against a second predetermined profile to thereby evaluate the interest of the selected candidates in attending the institution.
22. However, CollegeEdge does teach the candidate filling out an initial profile survey - Universities selecting matching profiles and sending the candidate an electronic message with additional information about the school and it's programs ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999).
23. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to request more information from the candidates through the electronic message to clarify the candidate current standing (in regard to finding a college), and resubmitting the answers of the survey back through the evaluating system disclosed by CollegeEdge.
24. As per Claim 10, CollegeEdge discloses wherein the electronic request includes the steps of: constructing an electronic survey; locating the electronic survey on a web page at the web site of the institution; create a unique access number for each candidate; providing each candidate with his unique access number in an e-mail request for information by an electronic survey; and automatically updating the data base with the responses from the

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electronic survey ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999; and www.collegeedge.com).

25. As per Claim 11, CollegeEdge discloses (g) preparing a mailing list of selected candidates as a function of the evaluated continued interest ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999; and www.collegeedge.com).

26. As per Claim 12, CollegeEdge discloses wherein the data base includes a list of available documentation relating to preselected features of the institution; and including the further steps of: (h) selecting available documentation as a function of the electronic responses to the electronic request for information, and (i) mailing the selected documentation to each of the selected candidates on the mailing list ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999; and www.collegeedge.com).

27. As per independent Claim 13, CollegeEdge discloses a method for profiling an inquiry pool of candidates in attending an institution of higher learning preliminarily to providing an application for enrollment, the method comprising the steps of: (a) providing a data base including information related to candidates for enrollment and the preferences of the institution for students with predetermined characteristics; (b) electronically evaluating the candidates in the data base against a first predetermined profile; and (f) providing a report of the electronic reevaluation.

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28. CollegeEdge fails to expressly disclose (c) providing a web page for the institution, the web page housing a survey requesting predetermined information related to the continued interest of candidates in enrolling at the institution; (d) sending an e-mail to the selected candidates directing them to the institution's web page; (e) electronically reevaluating the selected candidates in the data base against a second predetermined profile to thereby gauge the continued interest of the selected candidates in attending the institution.
29. However CollegeEdge does teach a candidate filling out an initial profile survey - Universities selecting matching profiles and sending the candidate an electronic message with additional information about the school and its programs ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999).
30. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a website link or address in the electronic message to the candidate and to request additional information from the candidates to clarify the candidate current standing (in regard to finding a college), and resubmitting the answers of the survey back through the evaluating system disclosed by CollegeEdge ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions, Announces Success of Enrollment Services System, Business Wire, March 1, 1999).
31. As per Claim 14, CollegeEdge discloses wherein selected candidates are directed to the web page by a hyperlink which uniquely identifies the candidates to whom the e-mail is sent so that the survey includes information relating to the candidates when it initially appears ("CollegeEdge, the Leading Provider of Web-based Services to Educational Institutions,

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Announces Success of Enrollment Services System, Business Wire, March 1, 1999; and
www.collegeedge.com).

Conclusion

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

33. The following patents are cited to show the best domestic (patented) prior art found by the examiner:

U.S. Pat. No. 5,966,695 to Melchione et al.

Melchione discloses an electronic sales and service support system and method for identifying sales targets using a centralized database to improve marketing success.

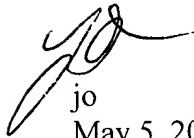
34. The following foreign patent is cited to show the best foreign prior art found by the examiner:

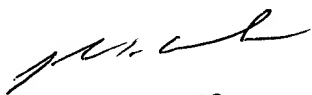
PCT No. WO 9849641 A1 to Root et al.

Root discloses a system and corresponding method, which provides complete functionality for creating and implementing marketing campaigns. The system formulates criteria for targeting clients based on marketing strategies, identifies and extracts targeted clients from a data warehouse, automatically generates leads/clients and tracks contact with such clients.

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35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
36. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.
37. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.


jo
May 5, 2003


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600